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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,059	04/12/2001	Yong Lung Wei	514-039-11	5262

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WARE FRESSOLA VAN DER SLUYS &
ADOLPHSON, LLP
BRADFORD GREEN BUILDING 5
755 MAIN STREET, P O BOX 224
MONROE, CT 06468

EXAMINER

FOSTER, JIMMY G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 10/20/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,059

Applicant(s)

WEI, YONG LUNG

Examiner

Jimmy G Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 17-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 17-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Claims 2 and 9-16 have, and claims 1, 3-8 and 17-25 are pending.

2. The original patent has not been surrendered. Applicant is reminded that this reissue application will not be allowed until the original patent (or affidavit of loss thereof) is actually surrendered.

3. Claims 1, 3-8 and 17-25 are finally rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. This reissue has corrected errors which were not addressed in the original declaration.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

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4. The affidavit of Yong Lung Wei filed on May 23, 2003 has been considered by the examiner. It is acknowledged by the examiner that the affidavit states that Mr. Wei was under the obligation to assign his rights to Maxtech at the time his invention was made.

The affidavit of Kailash C. Vasudeva filed on May 23, 2003 has also been considered. The examiner acknowledges that this affidavit states that Maxtech is the assignee of the Patent Numbers 5,803,254, 5,887,715, 6,105,767, and 6,105,770 and that the subject matter of each of the patents was obligated to be assigned at the time that each of the respective inventions was made. (No mention is made regarding this obligation at the time that Mr. Wei's invention (5,893,457) was made.)

Accordingly, it is established by the cumulative statements of the affidavits that at least the subject matter of applied patent number 6,105,770 was owned by, or obligated for assignment to, Maxtech both before the invention (Pat. No. 5,893,457) of Mr. Wei was made and after the invention of Mr. Wei was made. However, ownership, or obligation to ownership, of the subject matter of Vasudeva patent (6,105,770) when the invention of Mr. Wei was made still appears to be open to question.

The examiner recognizes/concedes that the actual filing of patent number 6,105,770 is after the filing date of the patent number to Mr. Wei. Therefore, it would be virtually impossible to declare that the patent number 6,105,770 was commonly owned at

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the time that Mr. Wei's invention was made. However, 35 U.S.C. 103(c) refers to prior art subject matter and not necessarily to patents. (But it is agreed that a statement with respect to the common ownership with a patent otherwise normally is sufficient to establish common ownership with the subject matter of the patent.) Patent number 6,105,770 constitutes applied prior art only because there is a reliance by the examiner on the effective reference date of the patent in the rejections made, wherein the effective reference date is based upon the filing dates of the parent applications 08/979,879, 60/054,935, and 60/077,470. Accordingly, if the subject matter of each of these applications was assigned to Maxtech, or obligated to be assigned to Maxtech, at the time the invention of Mr. Wei's patent was made, then proper use of patent number 6,105,770 in a 35 U.S.C 103 rejection would be obviated. An appropriately worded declaration to this effect (in concert with the foregoing declarations of this case) would remove the applied patent from use in any such rejection. Claims could then be appropriately rejected only under 35 U.S.C. 102(e) when using the subject matter of the reference (see MPEP 2146).

5. Claims 18 and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

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application was filed, had possession of the claimed invention. More specifically, the limitation calling for the first side wall to be integral with the back wall (claim 18) is considered to be new matter since the specification does not call for this and since the integral nature is not inherent in the drawings.

In addition, the limitation calling for the separating board to be integral with the back wall (claim 21) is considered to be new matter since the original specification does not call for this and since the integral nature is not inherent in the drawings.

6. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 21 there is no antecedent basis for "said base," making it unclear what relationship the base has with respect to the base portion already claimed.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

(e) the invention was described in

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(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 6-8 and 17-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Vasudeva (6,105,770). The apparent *effective filing date* of the Wei patent is the actual filing date: April 10, 1998. An *effective reference date* of the Vasudeva patent is at least November 26, 1997 since the patent is a continuation-in-part of the parent application 08/979,879 which itself includes all of the subject matter claimed. In addition, the patent has domestic priority to the provisional application 60/054,395, giving the patent an effective reference date of August 8, 1997 for some claimed subject matter. Therefore, the patent to Vasudeva constitutes a patent of another which was filed as an application in the United States before the invention by applicant (Mr. Wei) for patent.

The tool box of Vasudeva includes a main box 1 and a lid 2. Receiving members are defined by the pivotable holders 10 and are provided within the interior of said main box. The lid 2 constitutes means mounted at 3 to the base portion so as to cover the receiving members when in a closed position and to provide

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access to the interior of the base portion and the receiving member when in the open position, as indicated in Figure 5.

The receiving member holding compartment is shown such as in Figure 3 or 5 and may be considered to define a base portion. Depending on the perspective of the viewer, the compartment wall near the hinge 3 may be considered to be either a bottom or a top, with the opposite wall of the compartment (intermediate of the box) being considered to be the other of the bottom or top. The compartment side walls 14 (see col. 3, lines 50-52) define the base portion side walls. The wall opposite the opening of the compartment defines a back wall. See the perspective of the view shown, for example, in Figure 6.

The tool box further includes sliding plates at gang bars 18. The gang bars may be considered to be sliding plates since the term "sliding" is broad enough to not only define movement with contact, but also gliding/non-contact movement. The reference further discloses plural gang bars/sliding plates, wherein a gang bar/sliding plate will be provided on each side of the holders (col. 3, lines 63-67).

In one embodiment, the gang bars/sliding plates may be pivotally attached to the ends of the receiving members at a location that is rearwardly of the pivot connection between the receiving members and the wall, as indicated in Figures 9 and 10 of the reference. Thus the sliding plates may be connected at a rear side of the end of the receiving member. In addition, the

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connection between the receiving member and the wall may be at a front side of the receiving member since the term "front side" is broad enough to include any location that is forward of any considered reference location and not just forward of the center of the end.

Regarding the limitation calling for an actuating member, one of the receiving members 10 of Vasudeva may be considered to be an actuating member since it is capable of being actuated, such as in a manner shown in Figure 3 or 5.

Regarding claim 6, which calls for the walls to include apertures and the ends of the receiving members to include stubs, Figure 2 of Vasudeva shows such structure.

It is noted that unlike claim 1, Applicant's claim 17 does not require that the connection of the sliding plate be connected to the rear side of an end of the receiving member or actuating member and does not require that side wall be connected to the front side of the receiving member or actuating member.

Regarding claim 17, the reference of Vasudeva may be interpreted differently, wherein the wall 14 of Vasudeva may be considered to define a separating board, with the exterior-most end walls (unnumbered) of the bottom box portion 1 defining the side walls. The examiner asserts that said side walls may be considered to be generally parallel to each other and to said separating board 14, insofar as Applicant has claimed, since all are oriented in the same direction. The receiving members (some

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of holders 10) are pivotally mounted to the separating board 14. One of the holders 10 may be considered to be an actuating member instead of a receiving member.

Regarding the claim 17 limitation which calls for said actuating member to be pivotally mounted between the first side wall and the second side wall, the limitation "pivotally mounted between" is broad enough to mean "pivotally mounted somewhere between" and does not necessarily mean "pivotally mounted to and between." Accordingly, the opposite ends of the front portions of said actuating member (one of holders 10) may be said to be pivotally mounted between the side walls (exterior-most ends) even though it is attached to the separating board (like the other holders 10).

Regarding claim 21 which calls for the separating wall to be integral with the back wall, the separating board 14 is integral with the back wall/bottom of the tool case, as shown in Figure 4.

Additionally regarding claim 22 which calls for more than one receiving member, this is met by the description of the reference, wherein the case may include additional holders (col. 4, lines 8-9).

9. Claims 17-20, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Howard (4,531,646). The reference of Howard discloses a product display rack, with tiltable tray and

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insert assemblies 20,32. The rack frame 12 includes a back/rear wall 13 and side members/walls 14,15. [A header assembly 16 defines a top, and the base 18 defines a bottom.] This combination defines a box/base portion.

The box of Howard is inherently capable of holding tools of appropriate size, and such a capability meets the limitation, "tool box" claimed by Applicant.

Insofar as claimed by Applicant, one of the vertical members 26 against one of the walls (e.g. 15) may be considered to define a separating board inasmuch as it will separate (i.e. delineate) one portion of the interior of the frame (e.g. a portion in front of the member 26) from another portion of said interior (e.g. a portion to the rear of the member 26). This separating board 26 may be said to be spaced a distance from an opposite one of the walls (e.g. 14).

The tray assemblies 20,32 define receiving members since they include channeled recesses between partitions 31 for receiving articles or packages therein. The receiving members are attached to the vertical members 26.

Defining sliding plates are the members 24 which slide with respect to the side walls 14,15. The opposite ends of the rear portions of said receiving members are pivotally attached to said sliding plates 24 away from the pivot points 28 located on the vertical members 26.. The attachment interconnects the rear portions so that the receiving members will simultaneously tilt

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and so that actuation of one receiving member 20,32 will automatically result in similar movement from other receiving members (col. 2, lines 62-67). Accordingly, any of the receiving members can be also defined as an actuating member.

Regarding the claim 17 limitation which calls for said actuating member to be pivotally mounted between the first side wall and the second side wall, the limitation "pivotally mounted between" is broad enough to mean "pivotally mounted somewhere between" and does not necessarily mean "pivotally mounted to and between." Accordingly, the opposite ends of the front portions of said actuating member 20,32 may be said to be pivotally mounted between the side walls 14,15 even though it is attached to vertical members. In addition, regarding the limitation calling for the receiving member to be pivotally mounted between the first side wall and the separating board, this is broad enough to be met by the location of the receiving member being between the side wall 14 and the opposing separating board/vertical member 26, in combination with the pivotal attachment of the receiving member to the opposing vertical members 26.

Regarding Applicant's claim 19 which does call for the receiving member and actuating member to be pivotally mounted to the first side wall, this also does not distinguish over the structure of Howard since Applicant is only claiming one separating board and since the vertical member 26 on the first

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wall 14 of Howard may be considered to be a part of the first wall.

10. Claims 24 and 25 would be allowable if an appropriate supplemental reissue declaration is filed so as to overcome the rejection under 35 U.S.C. 251 set forth in this Office action

11. Claims 3-5 would be allowable if an appropriate supplemental reissue declaration is filed so as to overcome the rejection under 35 U.S.C. 251 set forth in this Office action and if the claims are amended to include all of the limitations of the base claim and any intervening claims, so as not to depend from a rejected claim.

12. Applicant's arguments filed September 4, 2003 have been fully considered but they are not deemed to be persuasive. Applicant has argued that the pivot means on the ends of the receiving members (10) of the Figures 7-15 of Vasudeva ('770) are not on the front side of the ends but in the center of the ends. The examiner is not persuaded by this argument since the term "front" is relative and broad enough to include a portion forward of any reference point, even including the back edge of the end.

Applicant has argued (regarding claim 17) that the reference of Vasudeva does not include a separating board. The examiner responds that the limitations claimed by Applicant

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regarding a separating board do not distinguish over the wall 14 of Vasudeva (the claimed side walls being read on opposite exterior-most ends of the main box portion 1.

Applicant as also argued that the reference of Vasudeva does not include the shorter receiving member and the longer actuating member called for in Applicant's claim 17. The examiner responds that there is no such limitation in claim 17 which call for relative lengths of the receiving and actuating members.

Applicant has argued that one of the vertical members 26 of Howard is not a separating board since it is not spaced from the sidewalls (plural). The examiner is unpersuaded by this argument since there is no limitation claimed by Applicant calling for the separating board to be spaced from both of the side walls. What is claimed is that the separating board is spaced from the first side wall, which is met by the separation of either vertical member of Howard from the opposing side wall. For example, the vertical member 26 of Howard, which is against the wall 15, is spaced from the wall 14.

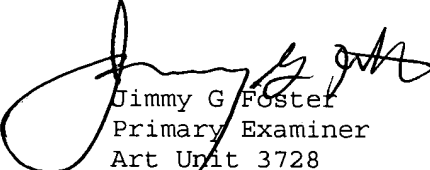
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy G Foster whose telephone number is (703) 308-1505. The examiner can normally be reached on Mon-Fri, 8:45 am - 5:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be

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reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Jimmy G Foster
Primary Examiner
Art Unit 3728

JGF
17 October 2003